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09/620,617

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Terry A. Smith

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EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/620,617

Applicant(s)

SMITH ET AL.

Examiner

CHAN S. PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8,10-14,18-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8,10-14,18-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 6/15/05, and has been entered and made of record. Currently, **claims 1, 5, 6, 8, 10-14, 18-20 and 22-25** are pending.

### *Response to Arguments*

2. Applicant's arguments, see page 6, filed 6/15/05, with respect to claim objection and rejections under 101 and 112, have been fully considered and are persuasive. The objection and rejections of claims have been withdrawn.

3. Applicant's arguments filed 6/15/05, with respect to the 102 and 103 rejections, have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the 102 and 103 rejections of claims 1, 8, 10 and 14, wherein on pages 6-8, the applicant explains how the current invention differs from the teachings of Suzuki (U.S. Patent No. 5,923,013). Particularly, the applicant states that "there is nothing in Suzuki that even remotely suggests anything at all about printing images that occur more than once in a document." However, examiner notes that the applicant is highly relying on the limitation that is not claimed in the current claims. There is nothing in the claims that even remotely suggest anything at all about printing images that occur more than once in a document. If the applicant wishes the definition of the term to be clearly considered and limited only to that definition, it is respectfully requested to specifically add the definition into the

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current claims. Absence of such a recitation, examiner has the right to read the claims with *the broadest reasonable interpretation*. Furthermore, even if the applicant's definition is considered, Suzuki clearly shows that the same images occur more than once in a document. Referring to fig. 24, for example, each page (images) can be printed more than once based on the print commands.

Moreover, the applicant states "[t]he question of whether rasterizing saved print data (or not) in Suzuki constitutes the use of the "same" video data or "new" video data is irrelevant to the claimed invention. The claims are directed to printing each instance of a recurring image with the same video data or with new video data whether or not that data has been rasterized. Suzuki just isn't relevant to the claimed invention." The applicant appears to state that the applicant's invention, the same and new video data, is irrelevant to rasterizing process in the printing system. However, this statement is different from what the Specification discloses. Referring to page 9, lines 1-22, it clearly defines the difference between the two video data by relating them to the RIP 370. If the applicant is relying on some other definitions of the two video data, it is uncertain as to how they are different and where they are shown in the Specification. Since the applicant's statement brings much confusion to clearly point out the invention, the limitation should remain rejected until further clarification is provided.

As the applicant's Specification discloses, Examiner interpreted the already expanded print job of Suzuki as the same video data and the newly expanded/ripped print jobs as the new video data. It is respectfully noted that the applicant fails to clearly distinguish the differences in the current claim wording.

With respect to claim 1, Suzuki teaches a means for responding to an indicator indicating printing (1) each instance of a form (printing of each page in fig. 24), (2) from the same video data (RipFileSave 56) (3) according to a first printing algorithm (printing the print job from the already-expanded print jobs), and (4) from new video data (JobSave 54) (5) according to a second printing algorithm (printing the print job from the newly rasterized print job).

With respect to claim 10, Suzuki teaches responding to a parameter being set to a first value (RipFileSave 56) indicating printing (1) each instance of a form (printing of each page in fig. 24) (2) from the same video data (the already-expanded print jobs) (3) by converting (ripping or rasterizing) the named sequence into video data (expanded) and then using the video data to print each instance of the form (printing the print job from the already-expanded print jobs), and responding to the parameter being set to a second value (JobSave 54) indicating printing each instance of the form (4) from new video data (newly expanded/ripped print jobs) (5) by converting the named sequence into display list data (S201) and then (6) using the display list data to print each instance of the form (S202 in fig. 17).

With respect to claim 14, Suzuki teaches a means for generating a plurality of commands including a named sequence (1) describing a form (print job 10 and JDF in fig. 4) and including at least one command (RipFileSave 56) (2) indicating permission is granted to convert the named sequence once into video data (the already-expanded print jobs) and to then print each instance of the form from the video data (printing the print job from the already-expanded print jobs) or (3) at least one command (JobSave

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54) indicating new video data is to be generated to print each instance of the form (printing the print job from the newly rasterized print job).

The same analysis applies to Claims 22-25.

4. For all of the reasons noted above, the rejection of claims 1, 8, 10, 14 and 22-25, as cited in the Office action dated 3/15/05, is maintained and repeated in this Office Action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 5, 6, 8, 10-14 and 18-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki.

5. With respect to claim 1, Suzuki discloses a printer, comprising:

an I/O port (acceptance module 76 and col. 9, line 67 – col. 10, line 5) capable of receiving a plurality of commands describing a document (print job 10 and JDF in fig. 4), the commands including both a named sequence (print job) describing a form and an indicator (JobSave 54 and RipFileSave 56 fields & col. 12, lines 10-27); and

means for responding to the indicator indicating permission is granted to print each instance of the form from the same video data (RipFileSave 56) by processing and printing the named sequence according to a first printing algorithm (printing the print job

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from the already-expanded print jobs) and for responding to the indicator indicating each instance of the form is to be printed from a new video data (JobSave 54) by processing and printing the named sequence according to a second printing algorithm (printing the print job from the newly rasterized print job).

6. With respect to claim 5, Suzuki discloses the printer of claim 1, wherein the plurality of commands are received from a computer (remote system) externally connected to the I/O port (114 in fig. 12 and col. 9, lines 67-68).

7. With respect to claim 6, Suzuki discloses the printer of claim 5, wherein the indicator is generated by the computer (col. 7, lines 21-23 & lines 44-53).

8. With respect to claim 8, Suzuki teaches a method of processing and printing a named sequence describing a form in a printer, comprising:

receiving the named sequence (print job 10 and JDF in fig. 4) and an associated parameter (JobSave 54 and RipFileSave 56 fields & col. 12, lines 10-27);

responding to the parameter being set to a first value (RipFileSave 56), indicating permission is granted to print each instance of the form from the same video data (the already-expanded print jobs), by converting (ripping or rasterizing) the named sequence into video data (expanded) and then using the video data to print each instance of the form; and

responding to the parameter being set to a second value (JobSave 54), indicating that each instance of the form is to be printed from new video data (newly expanded/ripped print jobs), by generating new video data (rasterized) to print each instance of the form.

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9. With respect to claim 10, Suzuki teaches a method of processing and printing a named sequence describing a form in a printer, comprising:

- a. receiving the named sequence (print job 10 and JDF in fig. 4) and an associated parameter (JobSave 54 and RipFileSave 56 fields & col. 12, lines 10-27);
- b. responding to the parameter being set to a first value (RipFileSave 56), indicating permission is granted to print each instance of the form from the same video data (the already-expanded print jobs), by converting (ripping or rasterizing) the named sequence into video data (expanded) and then using the video data to print each instance of the form; and
- c. responding to the parameter being set to a second value (JobSave 54), indicating each instance of the form is to be printed from new video data (newly expanded/ripped print jobs), by converting the named sequence into display list data (S201) and then using the display list data to print each instance of the form (S202 in fig. 17).

10. With respect to claim 11, Suzuki teaches the method of claim 8, wherein the named sequence and the associated parameter are received from a source externally connected to the printer (fig. 1; col. 7, lines 21-23; & lines 44-53).

11. With respect to claim 12, Suzuki teaches the method of claim 10, wherein the named sequence and the associated parameter are received from a source externally connected to the printer (fig. 1; col. 7, lines 21-23; & lines 44-53).



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12. With respect to claim 13, Suzuki teaches the method of claim 12, wherein step (c) comprises the following substep:

flagging the display list data as a candidate for caching (col. 12, lines 10-27).

13. With respect to claim 14, Suzuki discloses a computer (fig. 1; col. 7, lines 21-23; & lines 44-53), comprising:

means for generating a plurality of commands describing a document, the commands including a named sequence describing a form (print job 10 and JDF in fig. 4) and at least one command indicating (RipFileSave 56) permission is granted to convert the named sequence once into video data (the already-expanded print jobs) and to then print each instance of the form from the video data (printing the print job from the already-expanded print jobs) or at least one command (JobSave 54) indicating new video data is to be generated to print each instance of the form (printing the print job from the newly rasterized print job); and

means for transmitting the plurality of commands to a printer (JDF in fig. 4).

14. With respect to claim 18, Suzuki discloses the computer of claim 14, wherein the printer is responsive to the plurality of commands by printing the document (col. 11, lines 2-9).

15. With respect to claim 19, Suzuki discloses the computer of claim 14, wherein the printer is connected to the computer over a network (fig. 1).

16. With respect to claim 20, Suzuki discloses the computer of claim 14, wherein the plurality of commands forms a print job (figs. 2-4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Shimuzu U.S. Patent No. 6,052,202.

17. With respect to claim 22, Suzuki discloses a printer, comprising:

an input/output port (acceptance module 76 and col. 9, line 67 – col. 10, line 5)  
for receiving PDL print commands (fig. 1);

a control unit (system control module 74 in fig. 12) operatively connected to the  
input/output port;

a print engine operatively connected to the control unit (printer 104); and  
the control unit configured to respond to PDL print commands that include a  
named sequence describing a form and an indicator (print job 10 and JDF in fig. 4 & col.  
12, lines 10-27) by (1) if the indicator indicates permission is granted to print each  
instance of the form from the same video data (RipFileSave 56), processing the named  
sequence according to a first printing algorithm (printing the print job from the already-  
expanded/rasterized print jobs), (2) if the indicator indicates each instance of the form is  
to be printed from new video data (JobSave 54), processing the named sequence  
according to a second printing algorithm (printing the print job from the newly rasterized  
print job), or (3) if the indicator indicates the form is a fixed form (print job hold option52

in fig. 4), processing the named sequence according to the second algorithm (holding the print job in the memory 80 thus the data is fixed in the memory in col. 10, lines 47-49). In cases of (2) and (3), unrasterized/unprocessed print data is stored in the data memory 80, thus both process the print job according to the second algorithm.

Suzuki, however, does not disclose the indicator indicating the form is a background image and processing the named sequence according to a third algorithm.

Shimizu, the same field of endeavor of the printing art, discloses a printer that receives print data (in a PDL format) from a host wherein the print data includes an indicator indicating that a form is a background image (col. 14, lines 9-12). Moreover, when the background attribute is detected, a new printing process is performed (col. 14, lines 29-53 & col. 15, lines 17-28).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the print data including background attribute indicator of Shimizu with the printer of Suzuki.

The suggestion/motivation for doing so would have been to properly include image or foreground image data in the background data when a user requests a combination of foreground and background image.

Therefore, it would have been obvious to combine Shimizu with Suzuki to obtain the invention as specified in claim 22.

18. With respect to claims 23 and 24, arguments analogous to those presented for claim 22, are applicable. Also, see fig. 4 (HoldTiming 52, JobSave 54 and RipFileSave 56 fields).

19. With respect to claim 25, arguments analogous to those presented for claim 22, are applicable.

***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
August 30, 2005

Chan S. Park  
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